

REMARKS

The Present Invention

The present invention pertains to an antibody that is reactive with an immunogenic peptide of MART-1.

The Pending Claims

Claims 36-38 are currently pending and are directed to antibodies that are reactive with an immunogenic peptide of MART-1.

The Office Action

The Office has set forth the following requirement for restriction:

- (i) claims 1 and 9 as directed to immunogenic peptides of Mart-1, classified in class 530, subclass 324+;
- (ii) claims 15 and 22 as directed to immunogenic peptides of gp100, classified in class 350, subclass 324+; and
- (iii) claims 36-38 as directed to antibodies to Mart-1 or gp100, classified in class 530, subclass 387.1+.

The Office further requires an election between antibodies to Mart-1 or antibodies to gp100, if Group (iii) is elected.

The Amendments to the Claims

Claims 1-35 have been cancelled. Applicants reserve the right to pursue any cancelled subject matter in a continuation, continuation-in-part, divisional, or other application. Cancellation of any subject matter should not be construed as abandonment of that subject matter.

Claim 36 has been amended to recite "An antibody" in lieu of "Antibodies." Claim 36 also has been amended to recite the limitations of claims 1 and 9. Claims 37 and 38 have been amended in view of the amendments made to claim 36. Claim 38 also has been amended to correct the inadvertent error of being dependent on claim 37 and has been amended to be dependent on claim 36. No new matter has been added by way of these amendments.

The Discussion of the Restriction Requirement

There are two criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, and (ii)

In re Appln. of Kawakami et al.
Application No. 09/898,860

there must be a serious burden on the examiner if restriction is not required. M.P.E.P. § 803. Consequently, as set forth in M.P.E.P. § 803, "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."

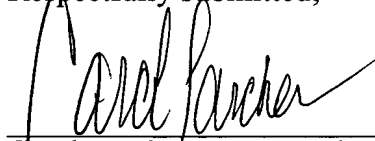
In the case at hand, the Office has not even so much as alleged that there would be an undue burden on the Examiner to examine all of the claims together. Applicants also point out that the Office has failed to establish an undue burden with respect to the requirement for election of species.

Furthermore, claims 1, 9, 15, and 22 have been cancelled and claim 36 has been amended to be directed to an antibody that is reactive with an immunogenic peptide of MART-1. In view of the amendments to the claims, the restriction requirement and election of species are moot.

Conclusion

The application is considered to be in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



Carol Larcher, Reg. No. 35,243
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

Date: August 18, 2003

\\Fs\clients\vnih\amd\218748 ROA1 Notice.doc